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Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			APPLE, KIRSTEN SACHWITZ	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/879,682  
Filing Date: June 11, 2001  
Appellant(s): SCHWEITZER, LIMOR

SCHWEITZER, LIMOR  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 1/9/08 appealing from the Office action mailed 8/9/07.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Hultgren, US Patent 6,868,391, March 15, 2005

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims. This is a verbatim copy of the final rejection mailed on 8/9/07.

**Detailed Action**

***Claim Rejections - 35 USC § 103***

The Examiner has read and reviewed all of the information provided by the Appellant. The examiner rejects as final claims 1-36 under 35 USC 103.

The Appellant attention is re-drawn to the following:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 & 18-28 & 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hultgren (U.S. Patent 6,868,391) in view of official notice.

**Re claim 1 & 18 & 35 & 36:** Hultgren discloses:

*A method, program & system for providing a digital wallet for IP usage utilizing a wireless network, comprising:*

*Prior to allowing usage of utility, receiving a request for a pre-paid debit account* (Hultgren, Figure 3A, Item 300, it is inherent that would you obtain a customer identification for those that request the payment transfer service or debit account)

*Prior to allowing usage, enabling pre-paid debit account* (Hultgren, Figure 3A, Items 306, 314 & 316, these are all three more specific steps of enabling the payment transfer service or debit account)

*Collecting payment over wireless network billing debit account* (Hultgren, Figure 3B, Item 328, 334 & 348, it is inherent that the collection is completed with the financial institution.)

*Collecting payment against debit account with IP over wireless network* (Hultgren, Figure 3B, Item 330, 334 & 348, it is inherent that the collection is completed with the financial institution.)

*Although Hultgren does specifically disclose payment for mobile phone usage (including voice and IP). The examiner claims office notice that mobile phone usage (including voice and IP) is a well know utility. Hultgren specifically uses the example of "utility bill, for example" (column 4, line 50)*

**Re claim 36:** Hultgren discloses:

*A method for providing a digital wallet for IP usage utilizing a wireless network, comprising:*

*Prior to allowing usage, receiving a account ID associated with a previous account of the user which is adapted solely for voice communication* (Hultgren, Figure 2, item 222C)

*Prior to allowing usage, authenticating an identity of the user* (Hultgren, Figure 2, item 222A)

**Re claim 2 & 19:** Hultgren discloses:

*Request received via mobile cellular hand set and debit account is enabled by human operator* (Hultgren, Figure 1, Item 60)

**Re claim 3 & 20:** Hultgren discloses:

*Wireless network via a mobile cellular handset (Hultgren, Figure 1, Item 50)*

**Re claim 4 & 21:**

*Uses WAP*

The examiner submits official notice that it is well known to one of ordinary skill in art at the time of the invention that WAP is a commonly used protocol for developing wireless applications and could be used for developing a mobile payment system.

**Re claim 5 & 22:** Hultgren discloses:

*IP includes data transfer (Hultgren, Figure 1, Item 50)*

**Re claim 6 & 23:** Hultgren discloses:

*IP usage includes payment for good or services (Hultgren, Figure 3)*

**Re claim 7 & 24 & 36:** Hultgren discloses:

*Transferring the payment from a first existing customer bank debit account before enabling the pre-paid second phone debit account in response to the request.*  
(Hultgren, Figure 3A, Items 306, 314 & 316)

**Re claim 8 & 25:** Hultgren discloses:

*Balance is updated in real-time (Hultgren, column 9, line 36-47, "immediately transfer funds")*

**Re claim 9 & 26:** Hultgren discloses:

*Alert is sent to a user when below predetermined amount ?? (Hultgren, column 7, line 40-47, "invalid transaction notification")*

**Re claim 10 & 27:** Hultgren discloses:

*Discontinued usage upon the debit account falling below a predetermined amount* (Hultgren, Figure 3A, Items 318)

**Re claim 11 & 28:** Hultgren discloses:

*Payment is received via a credit account* (Hultgren, Figure 3A, Items 306, 314 & 316)

**RE: Claims 12-15 & 29-32**

Claims 12-15 & 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hultgren (U.S. Patent 6,88,391) in view of official notice in further view of Foladare (U.S. Patent 5,914,472.)

**Re claim 12 & 29:** Foladare discloses:

*Limiting usage based on user-defined threshold* (Foladare, Figure 1, Item 104)

Hultgren & official notice describe a wireless payment process as described in Claim 1. However, Hultgren & official notice does not specifically disclose user-defined threshold. Foladare specifically defined this. (Foladare, Figure 1, Item 104)

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add user-defined threshold as taught by Foladare to previous references.

It is clear that one would be motivated to add flexibility to the process.

**Re claim 13 & 30:** Foladare discloses:

*Threshold expires after a pre-determine time limit*

The examiner submits official notice that it is well known to one of ordinary skill in art at the time of the invention that any variable set by the user can have time limits associated with it. This is just good business practice to never have user inputs without time limitations on these inputs.

**Re claim 14 & 31:** Foladare discloses:

*User-defined threshold limitation expires upon receipt of a key* (Foladare, Figure 1, Item 116, authorization – either through a key or other method)

Hultgren & official notice describe a wireless payment process as described in Claim 1. However, Hultgren & Official Notice does not specifically disclose user-defined threshold limitation. Foladare specifically defined this. (Foladare, Figure 1, Item 104)

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add user-defined threshold limitation as taught by Foladare to previous references.

It is clear that one would be motivated to add flexibility to the process.

**Re claim 15 & 32:** Foladare discloses:

*User may authorize payment of another users wireless network voice communication and IP usage upon receipt of the key by said user (Foladare, Abstract, “ancillary credit or debit card”)*

Hultgren & official notice describe a wireless payment process as described in Claim 1. However, Hultgren & Official Notice does not specifically disclose user key. Foladare specifically defined this. (Foladare, Figure 1, Item 104)

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add user key as taught by Foladare to previous references.

It is clear that one would be motivated to add flexibility to the process.

**RE: Claims 16-17 & 33-34**

Claims 16-17 & 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hultgren (U.S. Patent 6,88,391) in view of official notice in further view of Foladare (U.S. Patent 5,914,472) in further view of Holm-Blagg (US PG Published 2004/0030657 A1)

**Re claim 16 & 33:** Holm-Blagg discloses:

*Plural users may use wireless network voice communication and IP using a single debit account (Holm-Blagg, Figure 2, account 1 & 5, etc)*

Hultgren & official notice describe a wireless payment process as described in Claim 1. Additional, Foladare discloses parent-child credit card relationship. However, Hultgren, Official Notice & Foladare does not specifically describe plural users. Holm-Blagg clearly discloses a plurality of users. (Holm-Blagg, Figure 2, account 1 & 5, etc)



Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add plurality of users as taught in Holm-Blagg to previous references.

It is clear that one would be motivated to add flexibility to the process.

**Re claim 17 & 34:** Holm-Blagg discloses:

Limiting the usage for each of the users based on a single threshold associated with the debit account (Holm-Blagg, Figure 7B, “available credit line”)

Hultgren & official notice describe a wireless payment process as described in Claim 1. Additional, Foladare discloses parent-child credit card relationship. However, Hultgren, Official Notice & Foladare does not specifically describe a plurality of users. (Holm-Blagg, Figure 2, account 1 & 5, etc)

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add plurality of users as taught in Holm-Blagg to previous references.

*It is clear that one would be motivated to add flexibility to the process.*

#### **(10) Response to Argument**

##### **Argument for Independent Claim 1 and its Dependent Claims 2-14**

Appellant argues that “prior to allowing wireless network... receiving a request for a pre-paid account including payment therefor.”

The examiner refutes the argument and draws attention to Hultgren Figure 3A, item 300. This step clearly shows that the customer is contacted, it is inherent that if in the later steps of 306, 314 & 316 Hultgren obtains authorization for a financial institution for payment that a request was made.

Appellant argues that "enabling the pre-paid debit account" is not shown.

The examiner refutes the argument and draws attention to Hultgren Figure 3A, 306, 314 & 316. These three steps show the financial transaction is completed. This financial transaction is to pay a merchant for a service (in the case of the Appellant the service would be mobile usage (voice and IP) – see Hultgren, column 4, line 49 that supports this argument with an example that "\$100 US for a good or service". This service is "enabled" from a merchant once payment is received which is shown in Hultgren.

Examiners overall comment on Claim 1. At the end of the day this claim is no more than a debit payment system for all service companies: first a customer asking for a service, then service provider asking for payment, payment being received and final giving the customer the service. The service of the appellant is mobile service (voice and IP) but the process is the same that ever service company in the world. Claim 1 not only reads on Hultgren but lots of prior art and more importantly it infringes on how millions of businesses are conducting business on a daily basis. The examiner even re-read the spec and the appellants own Admitted Prior Art (on page 4) talks about how billing system are used for "the purpose of charging for wireless network vice communication using the debit billing account." The debit billing account what the appellant has in the independent claim. The appellant goes on the said that it "cannot be used to administer payment based on any type of IP specific usage" but says nothing more. The examiner is confused about why IP billing is a problem and what this invention is doing to solve it, especially since claim 1 is for voice and IP usage?

The additional remarks for the additional claims simply repeat the details in Hultgren and requote the appellants claims but the examiner believes there is no specific examples or arguments and therefore moot.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Kirsten S Apple/

Examiner, Art Unit 3694

Conferees:

/James P Trammell/

Supervisory Patent Examiner, Art Unit 3694

/Mary Cheung/

Primary Examiner, Art Unit 3694